

REMARKS/ARGUMENTS

The Applicant originally submitted Claims 1-20 in the application. In the present response, the Applicant amended independent Claims 1, 8, and 15. Support for the amendment can be found, e.g., in paragraph [0025] of the original specification. No other claims have been canceled or added. Accordingly, Claims 1-4, 6-11, 13-18, and 20 are currently pending in the application.

I. Formal Matters and Objections

The Examiner has objected to Claims 1 and 15 for lack of antecedent basis. More specifically, the Examiner asserts that the term “the group consisting of” in both Claims 1 and 15 lack antecedent basis and require appropriate correction. MPEP §2173.05(h) states ‘...One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being “selected from the group consisting of A, B and C.” See *Ex parte Markush*, 1925 C.D. 126 (Comm’r Pat. 1925)...’ (emphasis added). It is the understanding of the Applicant that the proper recitation of a Markush group, based on the cited portion of the MPEP, is “selected from the group consisting of A, B, and C.” As such, Claim 8 has been amended to be consistent with the Markush recitation of Claims 1 and 15 and, therefore, Claims 1, 8, and 15 have proper antecedent basis. Accordingly, the Applicant respectfully requests the Examiner to withdraw the objection to Claims 1 and 15 and allow issuance thereof.

II. Rejection of Claims 1-4, 8-11, and 15-18 under 35 U.S.C. §103

The Examiner has rejected Claims 1-4, 8-11, and 15-18 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,689,516 to Mack, *et al.* (hereinafter “Mack”) in view of U.S.

Patent No. 5,515,523 to Kalkunte, *et al.* (hereinafter "Kalkunte"). The Applicant believes the invention as presently claimed, however, is neither shown nor suggested in the cited portions of the combination of Mack and Kalkunte. More specifically, the Applicant fails to find where the cited portions of the combination teach or suggest of a partially disabled extent allowing a direct loopback between input and output pins of a testing port as now recited in amended independent Claims 1, 8, and 15.

The Examiner recognizes Mack is silent on an extent selected from the group consisting of: only partially disabled, and cites Kalkunte to cure this deficiency. The Examiner cites the Abstract, Fig. 2, and column 6, lines 4-13 of Kalkunte to assert that Kalkunte teaches the extent is selected from the group consisting of: only partially disabled. (See Final Rejection of August 8, 2008, page 3.) Claims 1, 8, and 15, however, have been amended to more clearly point out that a partially disabled extent allows a direct loopback between input and output pins of a testing port. The cited portions of Kalkunte, relied upon by the Examiner to cure the above-noted deficiencies of Mack, teach memory controller 20 monitors memory transfers request by bus A interface 30. If a volume of requests indicates that FIFOs contained in bus A interface 30 may be significantly backed up, then memory controller 20 partially disables memory transfers with bus B interface 40. When bus B interface 40 is partially disabled, a predetermined number of requests from bus A interface 30 will be granted before one request (if pending) from bus B interface 40 will be granted. Thus, the cited portions of Kalkunte teach partially disabling a bus interface while another bus interface can access a memory array. The cited portions of Kalkunte do not teach or suggest allowing a direct loopback between input and output pins of a testing port. As such, Kalkunte, as applied by the Examiner, does not cure the above-noted deficiencies of Mack.

Thus, the cited combination of the cited portions of Mack and Kalkunte, as applied by the Examiner and in view of the amendment, does not establish a *prima facie* case of obviousness of presently amended independent Claims 1, 8, and 15 and Claims that depend thereon. Accordingly, the Applicant respectfully requests the Examiner to withdraw the §103(a) rejection of Claims 1-4, 8-11, and 15-18 and allow issuance thereof.

III. Rejection of Claims 6 and 13 under 35 U.S.C. §103

The Examiner has rejected Claims 6 and 13 under 35 U.S.C. §103(a) as being unpatentable over Mack in view of Kalkunte, and further in view of the U.S. Patent No. 7,124,340 to Bos, *et al.* As established above, the cited combination of the cited portions of Mack and Kalkunte does not provide a *prima facie* case of obviousness of now amended independent Claims 1 and 8. Bos has not been cited to cure the above-noted deficiencies of the cited combination but to teach the subject matter of the above-mentioned dependent claims. (See Final Rejection of August 8, 2008, page 4.) As such, the cited combination of the cited portions of Mack, Kalkunte, and Bos does not establish a *prima facie* case of obviousness of presently amended independent Claims 1 and 8 and Claims that depend thereon. Accordingly, the Applicant respectfully requests the Examiner to withdraw the §103(a) rejection of Claims 6 and 13 and allow issuance thereof.

IV. Rejection of Claims 7, 14, and 20 under 35 U.S.C. §103

The Examiner has rejected Claims 7, 14, and 20 under 35 U.S.C. §103(a) as being unpatentable over Mack in view of Kalkunte and further in view of U.S. Patent No. 6,522,100 to Hansford (hereinafter "Hansford"). As established above, the cited combination of the portions of

Mack and Kalkunte does not provide a *prima facie* case of obviousness of now amended independent Claims 1, 8, and 15. Hansford has not been cited to cure the above-noted deficiency of the cited combination but to teach the subject matter of the above-mentioned dependent claims. (See Final Rejection of August 9, 2008, page 5.) As such, the cited combination of the cited portions of Mack, Kalkunte, and Hansford does not establish a *prima facie* case of obviousness of presently amended independent Claims 1, 8, and 15 and Claims that depend thereon. Accordingly, the Applicant respectfully requests the Examiner to withdraw the §103(a) rejection of Claims 7, 14, and 20 and allow issuance thereof.

V. Conclusion

In view of the foregoing remarks, the Applicant now sees all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicits a Notice of Allowance for Claims 1-4, 6-11, 13-18, and 20.

The Applicant requests the Examiner to telephone the undersigned agent of record at (972) 480-8800 if such would further or expedite the prosecution of the present application. The Commissioner is hereby authorized to charge any fees, credits or overpayments to Deposit Account 08-2395.

Respectfully submitted,

HITT GAINES, PC

A handwritten signature in black ink that reads "Steven J. Hanke". The signature is written in a cursive, flowing style.

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